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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,286	08/06/2001	Sauro Macerini	N-6811	9041
23456	7590	05/27/2004	EXAMINER	
WADDEY & PATTERSON 414 UNION STREET, SUITE 2020 BANK OF AMERICA PLAZA NASHVILLE, TN 37219			NGUYEN, DONGHAI D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/923,286

Applicant(s)

MACERINI, SAURO

Examiner

Donghai D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 67-90 is/are pending in the application.
- 4a) Of the above claim(s) 81-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 67-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 81-90 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 81-90 are independent and distinct from Claims 67-80. Claims 67-80 drawn to embodiment 1 readable on Figs. 1-14 and Claims 81-90 drawn to embodiments 2-4 readable on Figs. 15, 10, 21 as provided in the Office Action mailed on Dec. 11, 2002.

Since applicant has received an action on the merits for the originally presented invention (embodiment 1), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 81-90 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant's arguments filed on March 24, 2004 have been fully considered. However only claims 67-80, drawn to the elected invention (embodiment 1 readable on Figs. 1-14), are examined on the merits in the following Office Action. Claims 81-90 direct to non-elected invention and are not entitled to be rejoined to claim 67 since claim 67 is not an allowable generic claim.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 67, 68, 72, 74, and 75 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,430,613 to Hastings et al.

Regarding claims 67-68, Hastings et al disclose a method for producing an electrical component, comprising the steps of: providing a container (insulating material 24) including an exterior surface (top and/or sides surface in Fig. 2), an inner space (surface contacts coil 22), and an open base (opening covered by dielectric layer 20); providing a plurality of electrically conductive half-turns (26); and connecting the plurality of electrically conductive half-turns to the exterior surface of the container (Figs. 1-2).

Regarding claim 72, Hastings et al disclose the steps of: providing a sheet of electrically conductive material (38) including a plurality of electrically conductive shaped segments arranged in a predetermined pattern, an inner support structure (ring 39) connected to an inner edge of each shaped segment, and an outer support structure (inherent) connected to an outer edge of each shaped segment, and folding the plurality of shaped segments against the exterior surface of the container to form the plurality of half-turns (Figs. 1-3).

Regarding claim 74, Figs 1 and 2 show the plurality of half-turns bond to the exterior surface of the container.

Regarding claim 75, Hastings et al disclose the plurality of half-turns includes the step of providing a plurality of half-turns that include a plurality of portions extending past a lower edge of the container (Fig. 2); and the steps of folding the plurality of portions against or away from the lower edge of the container to form a plurality of folded portions (Fig. 2); providing a mounting support (12) including a plurality of welding pads (at the ends of conductive tracks 16) and a plurality of conductive tracks (16) connected to the plurality of welding pads; and

connecting the plurality of folded portions to the plurality of welding pads so that the plurality of half-turns and the plurality of conductive tracks form a plurality of complete turns connected in series, parallel, or a combination of both (in series in Fig. 4).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al in view of US Patent 5,101,086 to Dion et al.

Regarding claims 69 and 70, Hasting et al is silent about the container including synthetic resin and thermally conductive material. However Dion et al teach the container (18/19) having synthetic resin and thermally conductive material (Col. 3, lines 6-12) for transferring heat generated by the coil and core to the outside (Col. 1, lines 14-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hasting container to have synthetic resin and thermally conductive as taught by Dion et al for transferring heat generated by the coil and core to outside.

Regarding claim 71, Hasting et al disclose the electrically conductive half-turns including electrically conductive laminar material (flat metal conductor 26 making from lead frame 38).

*Allowable Subject Matter*

6. Claims 73 and 76-80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

7. Applicant's arguments with respect to claims 67-80 in Applicant's Response and Amendment received on December 19, 2003 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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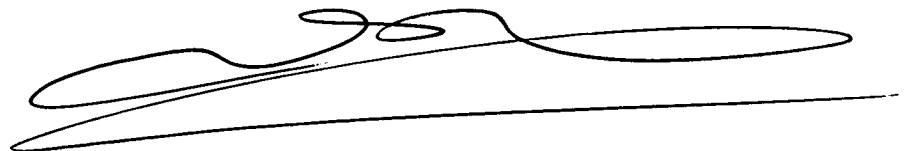
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (703) 305-7859.

The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN

A handwritten signature in black ink, appearing to read 'PETER VO', with a long horizontal line extending to the right.

**PETER VO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700**